

patent). Specifically, the Examiner stated that the Mahoney patent teaches all of the elements of Claim 1. The Applicants respectfully disagree.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” MPEP 5 2131 quoting *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). The Applicants respectfully submit that the cited reference does not contain all of the elements claimed in Claim 1.

Claim 1 claims, in part, “said reasoning element is configured to use a set of rules to extract metadata from the files” and “said reasoning element provides an output of 10 metadata.” The Examiner states that these elements are taught in col. 25, lines 20-39, col. 24, lines 37-58 and Figure 9 of the Mahoney patent. The Applicants respectfully disagree. Col. 24, lines 37-58 of the Mahoney patent begins with “FIG. 11 is a flow diagram which sets forth the steps in which the document corpus search system 140 ***generates user-crafted summary images*** of one or more document images.” (emphasis 15 added) Further, col. 25, lines 42-48 indicate that “FIGS. 12, 13 and 14 illustrate three different examples of composite summary images created using the steps outlined in FIG. 11. FIG 12 illustrates a summary image 1200 in which summary images 1202, 1204, 1206, and 1208 include layout objects corresponding to the header filed feature (e.g. 4-memo marks) of four document images.”

20 In all of the relevant lines cited by the Examiner, the discussion centers around summary images. However, the Applicants submit that summary images are not “metadata” as claimed in Claim 1. Rather, the summary images of the Mahoney patent are akin to image thumbnails or portions of images that are extracted from images based on a set of desired features. The Applicants are unclear how the Examiner is interpreting 25 these lines to teach “said reasoning element is configured to use a set of rules *to extract metadata from the files*” (emphasis added) and “said reasoning element provides an output of metadata” as is claimed in Claim 1.

Furthermore, Applicants submit that the Mahoney patent teaches away from “us[ing] a set of rules to extract metadata from the files” and “provid[ing] an output of metadata”. 30 Applicants refer the Examiner to col. 9, lines 23-26 of the Mahoney patent which states, “The document metadata 224 may be specified by a user at the time, or some time after, a

document image is scanned or otherwise added to the file system 117.” Further, col. 13, lines 38-40 of the Mahoney patent states, “Document metadata 224 for a document image can be entered by a user as type, date, title, and keyword information.” Thus, the Applicants submit that the Mahoney patent does not teach ‘us[ing] a set of rules to extract metadata from the files” and “provid[ing] an output of metadata,” because the Mahoney patent discusses manual entry of the metadata, and only indicates displaying selected images to a user. Thus, the Mahoney patent does not teach, disclose or suggest, “said reasoning element is configured to use a set of rules to extract metadata from the files” and “said reasoning element proves an output of metadata,” as is claimed in Claim 1.

10 Therefore, the Applicants submit that Claim 1 is patentable over the Mahoney patent.

Claims 2-8

Claims 2-8 are dependent upon Claim 1. For the reasons given above, the Applicants submit Claim 1 is patentable over the Mahoney patent. Therefore, the Applicants submit that Claims 2-8 are also patentable over the Mahoney patent at least though their dependency on an allowable base claim.

Claim 6

In section 3 of the Office Action, the Examiner rejected Claim 6 as being unpatentable over the Mahoney patent. Specifically, the Examiner stated that col. 22, lines 11-17 and col. 2, lines 17-47 taught the elements of Claim 6. The Applicants respectfully disagree.

Claim 6 claims, in part, “wherein said metadata is substantially comprised of title, author, affiliation, author affiliation, and table of contents.” The parts of the Mahoney patent cited by the Examiner indicate that the Mahoney patent teaches that the metadata may consist of type, date, title and keyword database. Given that the terms “substantially comprises of” indicates closed claim language, the Applicants submit that the discussion of metadata in the Mahoney patent is not “wherein said metadata is substantially comprised of title, author, affiliation, author affiliation and table of contents” as is claimed in Claim 6. Therefore, the Applicants submit that Claim 6 is patentable over the Mahoney patent.

Claims 9-16

Claim 9 is similar to Claim 1 in that Claim 9 claims, “using a set of rules in said
5 reasoning element to extract metadata from the files” and “providing an output of
metadata from said reasoning element.” Therefore, the same arguments presented above
in support of Claim 1 may also be applied to Claim 9. Therefore, the Applicants submit
that Claim 9 is also patentable over the Mahoney patent.

Claims 10-16 are dependent upon Claim 9. As previously mentioned, the Applicants
10 submit that Claim 9 is patentable over the Mahoney patent. Therefore, the Applicants
submit that Claims 10-16 are also patentable over the Mahoney patent at least through
their dependency upon an allowable base claim.

Claim 14

15 Claim 14 is similar to Claim 6. Therefore, the same arguments presented above in
support of Claim 6 may also be applied to Claim 14. Thus, the Applicants submit that
Claim 14 is also patentable over the Mahoney patent.